

Notice of Allowability

Application No.

10/713,893

Examiner

Kamal A Saeed

Applicant(s)

RONALD J. MATTSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to _____.
2. ☒ The allowed claim(s) is/are 1 and 2.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 11/14/2003
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

Petition

The petition filed under 37 C.F.R. 1.48(b), filed on November 14, 2003 to delete the names of the inventors who are not the inventors of the invention now claimed, have been entered in the file.

Information Disclosure Statement

Applicant's Information Disclosure Statements filed on November 14, 2003 has been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

Priority

This Application is a DIV of US Application No. 10/091,232 (currently allowed but not issued), filed on March 29, 2001 which claims priority from US Provisional Application Nos. 60/279,88 filed March 29, 2001, 60/293,122 filed May 23, 2001 and 60/327,804 filed October 9, 2001.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

The invention relates to a process for the preparation of 2-(indol-3-yl)-cyclopropane carboxylic acid ethyl ester and 2-(1H-indol-3-yl)-cyclopropane carboxylic acid tert-butyl ester wherein the N is protected. The process comprises the reaction of vinyl indol-3-yl group (wherein the Nitrogen is protected by benzenesulfonyl, methansulfonyl, p-toluenesulfonyl or trifluoromethanesulfonyl) with ethyl diazoacetate and toluene or tert-butyl diazoacetate and toluene in the presence of Ru complex of 2,6-bis(4R)-isopropyl-2-oxazolin-2-yl-pyridine as catalyst. The closest prior art of record is to Vangveravong et al (*J. Med.Chem.* **1998**, *41*, 4995-5001). Vangveravong et al teach a process of preparing 2-(indol-3-yl)-cyclopropane carboxylic

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acid ester comprising reaction of N-protected indolecarboxaldehyde with malonic acid and then reacting the product obtained with ethereal diazomethane in presence of catalytic Palladium diacetate. The instantly claimed process differ from the prior art in that the starting material and the catalyst used are different from the one described in the prior art. Moreover, the process of this application is a one step process. Therefore, the process described in this application is neither taught nor suggested by the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal A Saeed whose telephone number is (571) 272-0705. The examiner can normally be reached on M-T 7:00 AM- 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality

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requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

Kamal Saeed 06/26/04
Kamal Saeed, Ph.D.,
Patent Examiner, Art 1626